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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,665

03/11/2004

E. Marlowe Goble

13447.43

6304

22913

7590

04/17/2008

WORKMAN NYDEGGER
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EXAMINER

COMSTOCK, DAVID C

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

04/17/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/798,665	Applicant(s) GOBLE ET AL.	
	Examiner DAVID COMSTOCK	Art Unit 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-64 and 92-107 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-64 and 92-107 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12 OCT 2007, 21 JAN 2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 35-41, 43-45, 48-53, 55, 57-64 and 92-107 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin (4,673,407; cited by Applicant).

Martin discloses a tibial implant comprising a body with an articular surface 29 and a bone apposition surface. See, e.g., Figs. 6 and 9. A tray 64 retains a polymeric bearing plate 62. The device comprises articular surfaces with a track and key shape (see, e.g. Fig. 1 and 6, showing complementary track surface with a central key portion). A means for securing a fastener comprises a socket 90 formed on a stem extending from the bone apposition surface of the body. The stem extends at an angle of 90 degrees which is “about” 80 degrees. The articular surface is selectively connected to the tray (see col. 7, lines 65-68). The socket is configured to mate with an elongated fastener, e.g. 76. The fastener has a head or crown nut, e.g. 89, that is biased against a shoulder 81 of a bone anchor 78 that encircles the fastener.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42 and 56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (4,673,407; cited by Applicant).

Martin disclose the claimed invention except for explicitly reciting a stem length in the range of about 2 mm to about 6 mm and a fastener length in the range of about 5 mm to about 15 mm. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have selected any desired stem and fastener length, including, for example, the claimed ranges of about 2 mm to about 6 mm and of about 5 mm to about 15 mm, respectively, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 46, 47 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin (4,673,407; cited by Applicant) in view of Klawitter et al. (4,000,525).

Martin disclose the claimed invention except for the inlay of porous bone ingrowth material. Klawitter et al. also disclose a tibial implant 10 and teach providing an inlay 18 of porous bone ingrowth material to create a secure bond between the implant and natural bone "by favorably affecting bone tissue ingrowth" (see the sole figure and col. 1, lines 34-37). It would have been obvious to one having ordinary skill

in the art at the time the invention was made to have provided the tibial implant of Martin with a porous inlay, in view of Klawitter et al., in order to create a secure bond between the implant and natural bone by allowing for favorable bone tissue ingrowth.

Response to Arguments

Applicant's arguments filed 28 January 2008 have been fully considered but they are not persuasive.

In response to Applicant's remarks regarding the amended claims, it is noted that the device of Martin is still believed to satisfy the new claim language. Regarding amended independent claim 35, Martin discloses a device comprising a rigid fastener and a rigid body that are fixed to each other rigidly at least in a lateral direction, by virtue of their rigid construction and adjacent, constricted position. Examiner concedes that these components are not rigidly fixed together with respect to a movement direction along their axes; however, this is not claimed. Regarding independent claim 92, a distal end of the fastener is mounted to the implant and is engaged therewith via the spring. Moreover, the threaded engagement vis-à-vis the fastener and the bone maintains the engagement between the fastener and the body. As such, it is believed that the claims are still anticipated. If the threaded engagement were clearly defined in terms of male/female threaded portions on respective elements of the device, or the like, the present construction of the claims and rejection would likely not apply.

Conclusion

The prior art made of record by Applicant and not relied upon is considered pertinent to applicant's disclosure. For example, the following references cited by Applicant are noted: FR 2718953, WO 91/06260 (Fig. 6, Sec. A-A).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Comstock whose telephone number is (571) 272-4710. Please leave a detailed voice message if examiner is unavailable. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached at (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DC/

/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733